



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D C 20231

MEMORANDUM

TO: GROUP 3722 DIRECTOR

FROM: BOARD OF PATENT APPEALS AND
INTERFERENCES

SUBJECT: ORDER REMANDING TO EXAMINER

We are forwarding this application to
your Group for taking further action
consistent with the decision of the Board
remanding this appeal to the Primary Examiner.

Program & Resource Administrator
Board of Patent Appeals and Interferences
308-9797

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

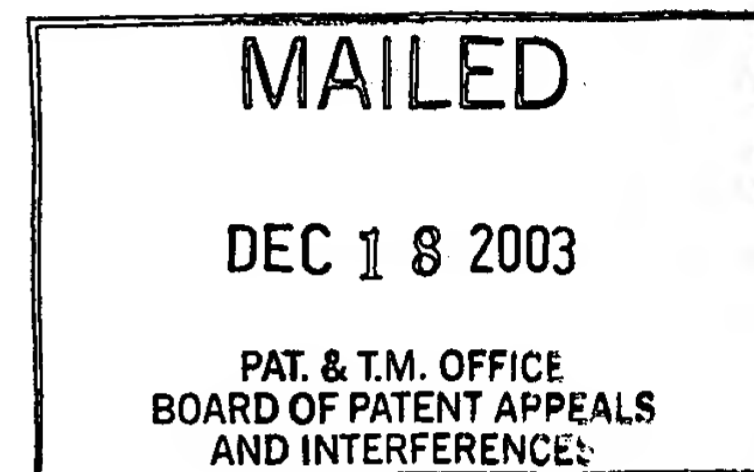
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID STUTSMAN

Appeal No. 2002-1238
Application No. 09/290,777

ON BRIEF



Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for appropriate action with regard to the items listed below.

1. Claims 1 and 3 through 20, all of the claims remaining in this application, stand rejected under 35 U.S.C. § 103(a) as being obvious over Nenninger (U.S. Patent No. 1,761,841) in view of Machinery's Handbook, 25th Edition, 1996, pages 2378-2379.

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The examiner's main focus is on Figures 1, 4 and 5 of Nenninger, wherein the examiner finds a spindle assembly for a machine tool comprising: a spindle (29) mounted in a housing and supported at one end by bearings (25, 26, Fig. 4) and at the other by a bearing (74, Fig. 5). With particular regard to Figure 5, the examiner notes that the bearing (74) seen therein includes an inner race and an outer race seated against an annular surface of a bushing or sleeve (70). As can be seen from Figure 5, the bushing/sleeve (70) is disposed between the outer race of the bearing (74) and the housing, and is received in an aperture or bore (71) in housing wall (11) and locked in place with respect to the housing wall by a stud screw (72). An oil distribution line (66) connects to sleeve (70) and feeds oil to bearing (74) to insure proper lubrication thereof. Among other things, the examiner recognizes on page 4 of the answer that Nenninger shows the bearing (74) seated within and abutting against an enlarged section of the sleeve rather than a bearing seat defined by an enlarged portion in bore (71) of the housing, as shown in the present application, and that Nenninger does not teach that the bushing/sleeve is held in place via an epoxy resin adhesive.

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With respect to the first of the differences noted above, the examiner contends on pages 4-5 of the answer that

it is immaterial to the function of Nenninger's invention as to whether the lips or flanges which form the outwardly facing annular surfaces are part of the sleeve, or whether these flanges are separate from the sleeves and are integral with the housing C (which if these flanges are integral with the housing, these flanges form enlarged openings within the housing by virtue of the smaller opening at the radially inner surfaces of the flanges.) Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the flanged portions of the sleeves integral with the housing, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

However, we are at somewhat of a loss to understand exactly what modifications the examiner intends to make in the arrangement seen in Figure 5 of Nenninger as a result of the above-noted assertions and exactly where in Nenninger any teaching, suggestion or incentive for such modifications may be found. Thus, we REMAND for further clarification of the exact modifications intended by the examiner, some idea of what the examiner believes the resulting structure would look like, and for some indication on the examiner's part as to where, absent hindsight derived from appellant's application, any teaching or

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suggestion for such changes may be found. In that regard, we observe that the mere fact that some prior art reference may be modified in the manner posited by the examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

2. We also REMAND for the examiner to provide some indication as to where in the disclosures of Nenninger and the Machinery's Handbook the examiner finds a teaching or suggestion of the method steps as set forth in claims 11, 15 and 16, for example.

3. On February 26, 2002 appellant filed a reply brief (Paper No. 11). The reply brief includes 5 pages of argument and comments concerning what appellant has characterized as the examiner's unreasonably broadened interpretation of the terms "bearing seat" and "sleeve" as used in appellant's claims on appeal, and also contested other positions set forth by the examiner in the answer. In response to the reply brief, the examiner sent out Paper No. 12 (mailed March 8, 2002) informing appellant that the reply brief had been "entered and considered"

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and that the application was being forwarded to the Board of Patent Appeals and Interferences for decision of the appeal. Our problem is that the examiner has not provided us with her position concerning the various arguments presented by appellant in the reply brief. Thus, we REMAND this application to the examiner for a response on the record to the arguments raised by appellant in the reply brief.

4. On page 12 of the brief, appellant characterizes the examiner's combination of the applied prior art as merely suggesting replacement of the stud screw (72) of Nenninger with an adhesive, to prevent the bushing member (70) from rotating. Appellant then goes on to argue that neither of the applied prior art references

disclose a sleeve between the bearing seat and the bearings to provide perfect axial alignment between the spindle and the bearings, rather both only disclose a bushing member containing a bearing seat bonded with an adhesive to a housing with no sleeve between the bearing seat and the bearings (brief, page 13).

While we recognize what appellant's disclosed invention entails, on REMAND, the examiner may wish to consider whether claim 1 on appeal, for example, actually requires the sleeve set forth therein to be located "between the bearing seat and the

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bearings" as appellant has contended. Assuming from appellant's comments above that it would have been obvious to one of ordinary skill in the art to replace the stud screw of Nenninger with a metal-to-metal adhesive like that discussed in the Machinery's Handbook, for preventing the bushing member (70) from rotating, it appears to us that the modified Nenninger arrangement supporting the spindle (29) would include a housing "having at least one bearing seat" (contained somewhere within the housing, e.g., in the sleeve (70) as shown in Figure 5), a bearing (74) having an inner race and an outer race "disposed in said at least one bearing seat," a bushing or sleeve (70) disposed between the outer race of the bearing and said housing, bonded to said housing, and a spindle (29) carried by the inner race of the bearing and supported in the manner generally set forth in claim 1 on appeal.


A supplemental examiner's answer clarifying the issues discussed above would appear to be necessary and is hereby authorized. It follows that appellant should have an opportunity to respond to any such supplemental answer by way of a further reply brief. Note, for example, 37 CFR § 1.193(b)(1) and (b)(2).

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This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 1, Feb. 2003. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND TO THE EXAMINER

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

BOARD OF PATENT
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